

## REMARKS

Claims 1-23 were pending, all of which were rejected by the Examiner. Claims 1-3, 6, 7, 12, 13, 15-17, and 21-23 have been amended. Claims 5, 14, 20 have been canceled. As amended and cancelled, reconsideration is respectfully requested.

### **I. Specification**

The Examiner objected to the abstract of the specification. The Examiner suggested that the phrase "Disclosed are" in line 1 be deleted from the Abstract. The abstract of the invention has been amended to reflect the change suggested by the Examiner.

### **II. Claim Objection**

The Examiner objected to claims 3 and 13 on the basis of grammatical errors. Claims 3 and 13 have been amended as suggested by the Examiner.

### **III. Claim Rejections – 35 USC 102**

Claims 1-4, 6, 7, 9-13, and 16-21 have been rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (US 5,603,318). Claims 1-3, 6, 7, 12, 13, 16-17 and 21 have been amended. Claim 20 has been cancelled. As amended and cancelled, this rejection is respectfully traversed.

Amended independent claims 1, 7, 16 and 21 now all require "a plurality of drain holes spaced along substantially the length of [a] drain lumen." Even the Examiner concedes that Johnson does not disclose this feature. See Office Action, mailed March 1, 2006 at p. 11 ("Johnson discloses . . . except for the conduit comprising a plurality of holes spaced along substantially the length of the drain").

Independent claims 1 and 7 also now require a drain lumen that is configured to be inserted into a surgical wound, to rest against a substantial length of tissue in a surgical wound, and to drain fluid from a surgical wound.

Independent claims 16 and 21 similarly require implanting a surgical drain within a surgical wound and resting a drain lumen against a substantial length of tissue in a surgical wound. Johnson also does not disclose these features. Instead, Johnson's catheter is configured to be inserted into an artery or vein.

Claims 2-4, 6, 9-13, and 17-19 all depend from one of these independent claims and thus are also not anticipated by Johnson.

Claims 1-3, 5, 7, 16-19 and 21-23 have been rejected under 35 U.S.C. 102(b) as being anticipated by Takezawa et al. Claims 1-3, 6, 7, 16-17, and 21-23 have been amended. Claim 5 has been cancelled. As amended and cancelled, this rejection is respectfully traversed.

Independent claims 1 and 7 require an elongated conduit having a drain lumen that is configured to be implanted within a surgical wound. Independent claims 16 and 21 similarly require a drain to be implanted within a surgical wound. Takezawa et al. do not disclose this feature. The catheter in Takezawa et al. is configured to be inserted in the esophagus or stomach. See *e.g.*, Col. 1, lines 9-10.

Independent claims 1, 7, 16 and 21 also require the drain holes to be "spaced along substantially the length of the drain lumen." Again, Takezawa et al. do not disclose such a feature. To the contrary, Takezawa et al. only teach that the holes should be "near the tip portion of the main tube". *E.g.* Col. 3, lines 37-38.

Claims 1, 7, 16 and 21 also require a property of fluid within the drain lumen to be sensed by a sensor affixed to the lumen. Again, Takezawa et al. do not disclose this feature. The temperature that is measured is not of fluid within the catheter, and the pressure is not measured by a sensor affixed to the conduit.

Claims 1, 7, 16 and 21 also require the measurement of a biochemical property of the drained fluid. Again, Takezawa et al. do not disclose this feature. Pressure and temperature are not biochemical properties.

Claims 1, 7, 16, and 21 are therefore not anticipated by Takezawa et al. Claims 2-3, 17-19, and 22-23 all depend upon one of these independent claims and thus are also not anticipated by Takazawa et al.

#### **IV. Claim Rejections – 35 USC 103**

Claim 3 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson. As explained above, however, Johnson does not disclose several features of claim 1 (from which claim 3 depends), including a plurality of drain holes spaced along substantially the length of a drain lumen and a drain lumen configured to be inserted into a surgical wound, to rest against a substantial length of tissue in a surgical wound, and to drain fluid from a surgical wound.

Takezawa et al. and Kalib also fail to disclose these features. Although Takezawa et al. do disclose a plurality of holes, they only teach that these holes are “near the tip portion of the main tube”. *E.g.* Col. 3, lines 37-38.

There is also no motivation for modifying Johnson to add drain holes spaced along substantially the length of its catheter. To the contrary, the catheter in Johnson is inserted into the cardiovascular system, such as an artery or vein. *See Abstract*; col. 3, lines 28-30. The opening that is at the end of the catheter is to communicate with blood that is in the vicinity of an optical sensor, so as to allow a sample of this blood to be removed and tested and so as to measure its pressure. If holes were added along the length of this catheter, this would probably cause blood at other locations to be sampled and tested. This other blood is likely to have characteristics (e.g., pressure and oxygenation) that are different from the blood in the vicinity of its optical sensor, i.e., the blood that is of interest to Johnson. Thus, adding holes along the length of this catheter might cause errors. Adding holes along the length of this catheter might also lead to the depletion of too much blood from the patient, creating a health hazard.

Claim 3 is therefore not obvious in view of Johnson.

Claims 5 and 14 have been rejected under 35 U.S.C 103(a) as being unpatentable over Johnson in view of Russo et al. These claims have been cancelled.

The subject matter of claims 5 and 14 has in substantial part been incorporated into the other claims. The other claims, however, are not obvious in view of Johnson and Russo et al. As explained above, Johnson lacks many

features of the claims, such as a plurality of drain holes spaced along substantially the length of a drain lumen, and a drain lumen that is configured to be inserted into a surgical wound, to rest against a substantial length of tissue in a surgical wound, and to drain fluid from a surgical wound.

The Examiner nevertheless contends that it would have been obvious to modify Johnson to have included the spaced holes disclosed in Russo because “doing so would allow for body fluid to be drained from a body cavity along a substantial portion of the body cavity.” Office Action at p. 11 (mailed Mar. 1, 2006). However, the Examiner has not explained why the skilled artisan would have been motivated to have modified Johnson to drain blood along the length of its catheter, nor can applicant conceive of any good reason for having done so.

To the contrary, placing holes along the length of Johnson’s catheter would probably have introduced errors in the measurements that Johnson took, and might even have created a hazard, as explained above. As such, the Examiner has not demonstrated that there was a motivation in the prior art for adding holes along the length of Johnson’s catheter and thus has not established a *prima facie* case of obviousness. See MPEP §2143 (“To establish a *prima facie* case of obviousness, . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.”)

As also explained above, the Johnson catheter does not have a drain lumen that is configured to be inserted into a surgical wound, to rest against a substantial length of tissue in a surgical wound, and to drain fluid from a surgical wound. And, again, there is no motivation or suggestion in the cited prior art for making these further needed modifications to Johnson’s catheter.

Claim 8 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Yarger. This rejection is respectfully traversed. As explained above, Johnson lacks spaced holes and is not configured for insertion in a surgical wound. Yarger does not make up for either deficiency. The reasons set forth above in connection with Russo also apply equally here.

Claim 12 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Takezawa et al. This rejection is respectfully traversed. As explained above, neither Johnson nor Takezawa et al. disclose a plurality of drain holes spaced along substantially the length of a drain lumen or a drain lumen configured to be inserted into a surgical wound, to rest against a substantial length of tissue in a surgical wound, or to drain fluid from a surgical wound, all requirements of claim 7 (from which claim 12 depends).

Claim 13 appears to have been rejected under 35 U.S.C. 103 as being unpatentable over Johnson in view of Takezawa et al and possibly Tu et al. and Kalib. As best understood, this rejection is respectfully traversed. As explained above, neither Johnson nor Takezawa et al. disclose a plurality of drain holes spaced along substantially the length of a drain lumen or a drain lumen configured to be inserted into a surgical wound, to rest against a substantial length of tissue in a surgical wound, or to drain fluid from a surgical wound, all requirements of claim 7 (from which claim 13 depends). Neither Tu et al. nor Kalib appear to make up for any of these deficiencies.

Claims 14-15 appear to have been rejected under 35 U.S.C. 103 as being unpatentable over Johnson in view of Takezawa et al. Claim 14 has been cancelled. Claim 15 is dependent upon claim 12 which, for the reasons stated above, is not obvious in view of Johnson and Takezawa et al.

Claims 4, 6 and 9 appear to have been rejected under 35 U.S.C. 103(a) as being unpatentable over Takezawa et al. and, as to claim 4, in view of Tu et al. and Kalib. As understood, this rejection is respectfully traversed. These claims depend upon independent claims 1 or 7. As explained above, Takezawa lacks several features of these independent claims, and these features also are not taught by Tu et al.

Claim 8 has been rejected for a second time under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Yarger. This rejection is respectfully traversed for the reasons stated above in connection with the first instance of this rejection.

**V. Double Patenting**

The provisional double patenting rejection has been acknowledged. No further response is believed to be required to this provisional rejection at this time.

**VI. Conclusion**

Applicant respectfully submits that the above amendments place this application in a condition for allowance, which the Applicant respectfully solicits. If further prosecution of the application can be facilitated through an interview between the Examiner and the undersigned, the Examiner is invited to telephone the undersigned at the Examiner's convenience.

A petition for a three-month extension of time under 37 C.F.R. 1.136 and a Request for Continued Examination under 37 C.F.R. 1.114 are being filed contemporaneously herewith. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 501946 and please credit any excess fees to such deposit account and reference attorney docket no. 64693-102.

Respectfully submitted,

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